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09/523,283	03/10/2000	Robert M. Miller	10001063-1	6010

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/523,283

Applicant(s)

MILLER ET AL.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓ ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2&3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 14, 30, and 31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. For example, Claim 14, which depends on Claim 1, implements a virtual editor that was already present in the parent claim. Likewise, Claims 30 and 31, which both depend on Claim 15, execute instructions to perform the steps of Claim 15. None of these claims add any functionality to or further limit the parent claims. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-6, 10, 11, 13-16, 19, and 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Donohue et al(5,987,480).

Claims 1, 14, 15, and 30-32: Donohue discloses a system, method, program, and device for delivering a document, comprising:

- a. storing a plurality of content objects (col 7, lines 35-47 and col 8, lines 10-13); and
- b. retrieving one or more of the content objects to construct a customized document based on a user profile (col 11, lines 21-25).

Claim 2: Donohue discloses a system for delivering a document as in Claim 1 above, and further discloses that the user profile includes information regarding the user's interests (col 10, lines 20-23).

Claim 3: Donohue discloses a system for delivering a document as in Claim 2 above, and further discloses acquiring the user profile using both covert and overt processes (col 10, lines 20-23 and 43-48).

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Claims 4, 5, and 13: Donohue discloses a system for delivering a document as in Claim 1 above, and further discloses constructing the document based on information from a personal profile (user profile) and one or more key contributors, which the Applicant has defined in Claim 5 as the user's interests, demographics, seasonality, document server requirements, and content provider usage criteria (col 10, lines 20-23 and 43-48; and col 11, lines 21-25). The Examiner notes that the key contributor examples are the same type of information included in the user profile as claimed in Claim 2 above.

Claim 6: Donohue discloses a system for delivering a document as in Claim 1 above, and further discloses receiving and storing the content objects and then retrieving one or more content object to generate the personalized (customized) document (col 7, lines 35-47).

Claims 10, 11, and 16: Donohue discloses a system and method for delivering a document as in Claims 1, 6, and 15 above, and further discloses retrieving the content objects based on information from the user profile and one or more key contributors as discussed in the rejection of Claim 4 and 5 above (col 10, lines 20-23 and 43-48; and col 11, lines 21-25).

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Claim 19: Donohue discloses a method for delivering a document as in Claim 16 above, and further discloses distributing the document through an electronic delivery system (e.g. the Internet)(col 7, lines 25-34).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 12, 17, 18, 24, 25, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480).

Claims 7, 24, and 34: Donohue discloses a system, method, and device for delivering a document as in Claims 6, 15, and 32 above, but does not explicitly disclose using a non-invasive marking wrapper to uniquely identify and distribute the document. Official Notice is taken that it is old and well known to use wrappers to protect and to distribute documents, such as newspapers and magazines, and to place unique identifying indicia onto the wrapper (e.g. names and address of subscriber) to facilitate the distribution of the document. For example, the National Geographic magazine is distributed using a plain brown wrapper upon which the subscriber's name and address is printed, along with text and graphics identifying the publication and other information. The Examiner has been receiving this magazine wrapped in this manner for

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approximately 8 years. Furthermore, an electronic document sent to a subscriber is usually encapsulated in an email message that not only identifies the subscriber and the email address, but also includes a title or subject line to identify the document enclosed or attached to the email message. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to wrap the document in Donohue in a non-invasive marking wrapper which uniquely identifies the document and which can be used to distribute the document. One would have been motivated to use such a wrapper in view of the disclosure that the system will receive and store the user's Internet address and email address (col 10, lines 20-23 and 31-34) and then use such information to deliver a customized document to that user.

Claims 12, 17, and 18: Donohue discloses a system and method for delivering a document as in Claims 11 and 16 above, but does not explicitly disclose the content provider limiting the publishing of their content based on the publishing of content from another content provider, such as a competitor. Official Notice is taken that it is old and well known within the marketing arts for content providers to place limitations on when, how, and where their content can be published. One of the well known limitations is the proximity to other similar or competing content. For example, an advertiser for an alcohol product would not desire the advertisement to be published with an article directed towards the problems of drunk driving; nor would a tobacco producer want to advertise their product next to an article about the detrimental effects of cigarette smoke. Therefore, it would have been obvious to one having ordinary skill in the art at

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the time the invention was made to allow the content provider to place limitations as to the publishing of their content in respect to other content objects or competitors' content objects. One would have been motivated to allow such limitations in order to prevent conflicting content of being published together.

Claim 25: Donohue discloses a method for delivering a document as in Claim 24 above, and further discloses distributing the document through an electronic delivery system (e.g. the Internet)(col 7, lines 25-34).

Claim 33: Donohue discloses a system and device for delivering a document as in Claim 32 above, and further discloses constructing the document based on information from a personal profile (user profile) and one or more key contributors as discussed in reference to Claims 4, 5, and 13 above. While it is not explicitly disclosed that the user profile or key contributors include one or more of a season of publication, a geographic location of the requesting user, the document server features or limitations, or the content provider usage criteria, it would have been obvious to include at least the geographic location of the requesting user as part of the user demographics in the user's profile. It also would have been obvious to use the current time of the year (i.e. season) to determine the desirability of the content object, such as presenting a content object about ski resorts during the winter instead of during the spring or summer. As discussed above in reference to Claims 12, 17, and 18, it would have also been obvious to taken into account any limitations or usage (targeting) criteria designated by the



content provider, such as distributing an advertising content object only between the start and end dates of a promotional campaign as indicated by the content provider. One would have been motivated to use one or more of these criteria when compiling the document to distribute in order to provide a document which is more pertinent to the user.

6. Claims 8, 20-22, 26, 27, 29, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Rapaport et al (5,890,152).

Claims: 8, 20, 22, 26, 27, and 35: Donohue discloses a system, method, and device for delivering a document as in Claims 7, 19, 25, and 34 above, but does not explicitly disclose virtual sensors that will identify and report to the content manager information about the distribution, receipt, and user disposition of content objects. Rapaport discloses a similar system, method, and device for delivering a document (media file) over the Internet, and further discloses virtual sensors that will monitor and report the receipt and usage of the document by the user. For example, Rapaport discloses sensing “how long the user is looking at the section of the media file segment, if the sound file/video file is being accessed repeatedly, how fast is a scroll bar progressing on a text file segment, or is the media file segment printed, saved, or listened to” (col 12, lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to monitor and report the distribution, receipt and user disposition of the customized document in Donohue. One would have been motivated to track this type of information in order to provide more

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meaningful updates to the user's profile by determining if the content objects is of interest to the user as discussed by both references.

Claims 21, 29, and 36: Donohue and Rapaport disclose a system, method, and device for delivering a document as in Claims 20, 26, and 35 above, and both references disclose updating the user profile based on the received information (Donohue, col 7, line 49 – col 8, line 8)(Rapaport, col 2, lines 55-62).

7. Claims 9, 23, 28, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Rapaport et al (5,890,152) as applied to claims 8, 20, 26, and 35 above, and further in view of Griebenow et al (5,850,520).

Claims 9, 23, 28, and 37: Donohue and Rapaport disclose a system, method, and device for delivering a document as in Claims 8, 20, 26, and 35 above, but neither reference explicitly discloses initiating a financial transaction between the content manager and one or more of the content providers based on the collected monitoring data. Griebenow discloses a similar system, method, and device for delivering a document over the Internet which also discloses the content manager (publisher) initiating a financial transaction (charging) with a content provider (advertiser)(col 9, lines 47-48; col 10, lines 6-10 and 25-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to initiate financial

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transactions between the content manager and one or more content providers. One would have been motivated to conduct such financial transactions in order to make the system financially viable by allowing the content manager to be paid by advertising content providers for inclusion of their advertisements as in common in the publishing industry.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Reisman (5,694,546) discloses a system and method for delivering a document over the Internet.
- b. Stumm (5,768,528) discloses a system and method for delivering a document over the Internet using stored demographic profiles.
- c. Leymaster et al (6,182,095) discloses a system and method for generating and delivering a document over the Internet using store demographic profiles.
- d. Dimarco, et al (WO 99/08205) discloses a system and method for delivering a customized document.
- e. Chen et al (EP 1,039,396) discloses a system and method for producing and delivering a customized document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

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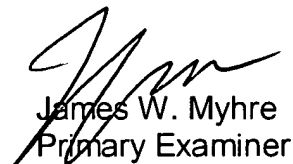
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal and Official faxes is (703) 872-9306. Draft or Informal faxes may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

January 15, 2004



James W. Myhre  
Primary Examiner  
Art Unit 3622